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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,477	09/10/2003	Gregory A. Piccionelli	39003.810US01	3434
7590 06/20/2006 Michael M. Gerardi, Esq. 28876 Woodcrest Lake Drive Menifee, CA 92584			EXAMINER OPARE ABETIA, JOSEPH C	
			ART UNIT 2165	PAPER NUMBER

DATE MAILED: 06/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,477

Applicant(s)

PICCIONELLI ET AL.

Examiner

Joseph C. Opare-Abetia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-20 rejected under 35 U.S.C. 102(b) as being anticipated by Steven Parker et al. (U.S. Pub. NO. 20030004997 and hereinafter as Parker).

With respect to claim 1, Parker discloses a method of producing a personalized data file, the method comprising the steps of: a) providing a message comprising at least one word to a person present at a site on a network and specifying a first data file (i.e., *"database of expressions categorized by occasions, the greeting card messages would be further personalized by interaction between the customer and the retail."*) The preceding text clearly indicates that a personal message is provided to a person located on the network, which in this case is the retail)(page 1 col.1 lines 36-39;fig. 3 element 6), and b) producing a personalized data file by digitally combining the first data file and the message, wherein the message is prepared by the person to whom the message was provided in step a) prior to being digitally combined with the first data file (i.e., *"online services over the Internet offer web customers the ability to select an image or graphic for the front of a greeting card and offer a standard greeting to be printed with the selected card or alternatively offer*

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the ability to type in a personalized message.” The preceding text clearly indicates that the system combines personalized message with other files)(page 1 col. 2 lines 1-6)

With respect to claim 2, Parker discloses a method wherein a message is provided to the person over a network (i.e., “*system will be accessible over a wired or a wireless wide area network including the Internet.*” The preceding text clearly indicates that the system is provided over a network)(page 2 col. 2 lines 1-2).

With respect to claim 3, Parker discloses a method wherein the first data file is specified by accessing a menu (i.e., “*services over the Internet offer web customers the ability to select an image or graphic for the front.*” The preceding text clearly indicates that there exists a menu for selection)(page 1 col. 2 lines 1-3).

With respect to claim 4, Parker discloses a method wherein the first data file comprises at least one image (i.e., “*ability to select a card image and type a personalized message.*” The preceding text clearly indicates that the use of image is being implemented)(page 1 col.1 lines 44-46).

With respect to claim 5, Parker discloses a method wherein the first data file comprises a photographic image (i.e., “*which preferably includes a high-quality, photographic image.*” The preceding text clearly indicates that a photographic image is being implemented)(page 4 col. 2 lines 48-49).

With respect to claim 6, Parker discloses a method wherein the message is written by the person using a device which produces a data file corresponding to the message, and wherein the data file so produced is digitally overlaid on the photographic image (i.e., *"At 425 the images can also be edited by the user to include and position text overlay, for example, "Happy 49.sup.th Birthday" John, or to also edit the image itself using certain templates 424 to facilitate the ease of the editing or combining images."*) The preceding text clearly indicates that overlay of messages is being implemented)(page 3 col. 2 lines 39-43).

With respect to claim 7, Parker discloses a method wherein the first data file is a video file comprising a plurality of frames (i.e., *"the selection or creation of a particular expression and also sometimes include audio or video files associated therewith as part of the presentation."*) The preceding text clearly indicates that video files are being used)(page 1 col. 1 lines 55-58)

With respect to claim 8, Parker discloses a method wherein the message is written by the person using a device which produces a data file corresponding to the message, and wherein the data file so produced is digitally overlaid on at least one of said plurality of frames (i.e., *"At 425 the images can also be edited by the user to include and position text overlay, for example, "Happy 49.sup.th Birthday" John, or to also edit the image itself using certain templates 424 to facilitate the ease of the editing or combining images."*) The preceding text clearly indicates that overlay of messages is being implemented)(page 3 col. 2 lines 39-43).

With respect to claim 9, Parker discloses a method wherein the first data file is selected from the group consisting of a graphic file and a text file (i.e., *“over the Internet offer web customers the ability to select images or graphics.”* The preceding text clearly indicates that the system selects graphics)(page 1 col. 2 lines 2-3).

With respect to claim 10, Parker discloses a method wherein the message comprises a script comprising dialog to be read by the person and the first data file is a video file (i.e., *“particular expression and also sometimes include audio or video files associated therewith as part of the presentation.”* The preceding text clearly indicates that video file is being used and one skilled in the art can claim of dialog to be read in the video)(page 1 col. 1 lines 560-58).

With respect to claim 11, Parker discloses a method wherein the dialog is read by the person and recorded to produce an audio file and wherein the audio file is digitally combined with the video file (i.e., *“particular expression and also sometimes include audio or video files associated therewith as part of the presentation.”* The preceding text clearly indicates that audio file and video files are being used)(page 1 col. 1 lines 560-58).

With respect to claim 12, Parker discloses a method wherein the personalized data file is provided to a user over a network (i.e., *“system will be accessible over a wired or a wireless wide area network including the Internet.”* The

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preceding text clearly indicates that the system is provided over a network)(page 2 col. 2 lines 1-2).

With respect to claim 13, Parker discloses a method of producing a recorded performance, the method comprising the steps of: a) providing a script to at least one person present at a site on a network, the script comprising dialog and directions for action, and b) recording a performance of the script by the at least one person (i.e., *“particular expression and also sometimes include audio or video files associated therewith as part of the presentation.”*) The preceding text clearly indicates that a particular expression which is also directions for action is given to be performed therefore one skilled in the art can claim of providing a script to at least one person present at a site on a network, the script comprising dialog and directions for action by one or more people)(page 1 col. 1 lines 560-58).

With respect to claim 14, Parker discloses a method wherein the script is provided to a plurality of persons present at the site, and wherein in step b) the script is performed by the plurality of persons (i.e., *“particular expression and also sometimes include audio or video files associated therewith as part of the presentation.”*) The preceding text clearly indicates that a particular expression, which is also directions for action, is given to perform by one or more people) (page 1 col. 1 lines 56-58).

With respect to claim 15, Parker discloses a method wherein the performance is subject to a record-keeping requirement and wherein information pertaining to

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the performance in accordance with the record-keeping requirement is combined with the recorded performance (i.e., *“selection of a particular image, the selection or creation of a particular expression and also sometimes include audio or video files associated therewith as part of the presentation.”* The preceding text clearly indicates that wherein information pertaining to the performance in accordance with the record-keeping requirement is combined with the recorded performance)(page 1 col. 1 lines 53-58).

With respect to claim 16, Parker discloses a method wherein the recorded performance is provided to a viewer over a network (i.e., *“system will be accessible over a wired or a wireless wide area network including the Internet.”* The preceding text clearly indicates that the system is provided over a network)(page 2 col. 2 lines 1-2).

With respect to claim 17, Parker discloses a method wherein premium is charged to a user providing the message (i.e., *“the cost of the greeting card charged to the user.”* The preceding text clearly indicates that a user is charged)(page 6 col. 2 line 10)

With respect to claim 18, Parker discloses a method wherein a personalized data file produced (i.e., *“with the selected card or alternatively offer the ability to type in a personalized message.”* The preceding text clearly indicates that a user can produce their own personalized data file or select it from a list)(page 1 col. 2 lines 4-6).

With respect to claim 19, Parker discloses a method wherein recorded performance produced (i.e., *"video files associated therewith as part of the presentation."*) The preceding text clearly indicates that a video file is associated with the presentation therefore the video need to be recorded first before it can be attached to the presentation so one skilled in the art can claim of recorded performance produced of the video file).

With respect to claim 20, Parker discloses a system for producing a personalized data file, the system comprising: a) means for accessing a site on a network (i.e., *"system will be accessible over a wired or a wireless wide area network including the Internet."*) The preceding text clearly indicates that the system is provided over a network)(page 2 col. 2 lines 1-2); means for providing a message to a person present at the site on the network (i.e., *"database of expressions categorized by occasions, the greeting card messages would be further personalized by interaction between the customer and the retail."*) The preceding text clearly indicates that a personal message is provided to a person located on the network, which in this case is the retail)(page 1 col.1 lines 36-39;fig. 3 element 6); means for selecting a data file (i.e., *"ability to select a card image and type a personalized message."*) The preceding text clearly indicates that the use of image is being implemented)(page 1 col.1 lines 44-46); means for enabling a person present at the site on the network to prepare the message (i.e., *"...alternatively offer the ability to type in a personalized message."*) The preceding text clearly indicates that the system allows a user to personalized their own

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message)(page 1 col. 2 lines 5-6); and e) means for combining the message prepared in step d) with the data file to produce a personalized data file (i.e., *“online services over the Internet offer web customers the ability to select an image or graphic for the front of a greeting card and offer a standard greeting to be printed with the selected card or alternatively offer the ability to type in a personalized message.”* The preceding text clearly indicates that the system combines personalized message with other files)(page 1 col. 2 lines 1-6).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph C. Opare-Abetia whose telephone number is (571) 272-6594. The examiner can normally be reached on mon-fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY A. GAFFIN can be reached on (571) 272-4146.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



JEFFREY GAFFIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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Joseph C. Opare-Abetia

Patent Examiner

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